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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

EX PARTE JEAN-LOUIS GUERET

Appeal 2008-4554  
Application 10/766,916  
Technology Center 3700

Oral Hearing Held: January 14, 2009

Before DONALD E. ADAMS, LORA M. GREEN and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANT:

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## PROCEEDINGS

MS. BOBO-ALLEN: Calendar Number 24, Appeal Number 2008-4554, Mr. Werking.

MR. WERKING: Thank you.

1 MS. BOBO-ALLEN: Um-hum.

2 JUDGE ADAMS: Good morning, Mr. Werking.

3 MR. WERKING: Good morning.

4 JUDGE ADAMS: 60,000 number?

5 MR. WERKING: Yes.

6 JUDGE ADAMS: Dang, that's great. Sorry for the delay. We had a  
7 problem with our transcriptionist this morning. She's here. She's ready.

8 MR. WERKING: That's okay.

9 JUDGE ADAMS: If you'd -- you'll have 20 minutes. We're familiar  
10 with your issues, and if you would start by introducing your colleagues and  
11 spelling your name into the record, we'd appreciate it.

12 UNIDENTIFIED SPEAKER: We're just observing.

13 JUDGE ADAMS: Oh, you're observing. Oh, well, welcome to you.

14 UNIDENTIFIED SPEAKER: Thank you.

15 JUDGE ADAMS: Okay. I apologize then. Begin by spelling your  
16 name into the record.

17 MR. WERKING: My name is Kip Werking, K-i-p, W-e-r-k-i-n-g.

18 JUDGE ADAMS: Please.

19 MR. WERKING: May it please the Board, I am here to review the  
20 rejections of the claims on appeal. The Office action rejects independent  
21 claim 1 under Section 103 over Manougian in view of Rago, and rejects  
22 independent claims 1, 38 and 39 under Section 103 over Seidler in view of  
23 Rago.

24 I will mostly be discussing the independent claims and, in particular,  
25 independent claim 1 from which the majority of claims depend. Claim 1

1 recites several features. I will discuss mostly the particular feature that the  
2 hinge is configured to hold the lid in an upstanding position relative to the at  
3 least one base portion. Claim 1 also recites that the hinge comprises hooks  
4 and loops. Just for ease of discussion, I will refer to these hooks and loops  
5 as Velcro, which is an embodiment disclosed in the application, with the  
6 understanding that the claim is not limited to that particular trademarked  
7 product.

8         There are two independent arguments for why the rejections of claim  
9 1 are in error. First, as argued on pages 4 through 6 of the reply brief, for  
10 example, the combination of Rago with either of Manougian or Seidler  
11 would not have been obvious. In other words, even if one of ordinary skill  
12 in the art had had Rago in front of them, that person would not have found  
13 the subject of claim 1 obvious in view of the references. Second, as an  
14 additional argument, Rago is not analogous art as argued on pages 2 through  
15 3 of the reply brief. That is, one need not consider what a person of ordinary  
16 skill in the art would have done with Rago in front of them because that  
17 person would not have encountered Rago in the first place.

18         I'll begin with the first argument. The crucial point to realize here and  
19 the primary point I want to convey in making the first argument is, that it is  
20 not predictable that any compact disclosed in Manougian or Seidler if  
21 modified to include a Velcro hinge would keep the lid in an upright position  
22 as recited in claim 1. It is not predictable that a Velcro hinge as disclosed by  
23 Rago would accomplish this function. Of course, it is desirable to have a  
24 box with a lid that stands upright. The purpose, as the drawings of this

1 application show, is that one can hold a compact and look into a mirror held  
2 upright on the lid while applying makeup, for example.

3 There is no disclosure in Rago or any of the applied references that a  
4 Velcro hinge could accomplish such a function. The reason why such a  
5 combination would not have been predictable is that Rago only discloses a  
6 Velcro hinge that keeps the edges of the game board together. There is no  
7 disclosure, explicit or implicit, that the Velcro hinge could keep one side of  
8 the board in an upright position. Further --

9 JUDGE FREDMAN: But isn't a person of ordinary skill, a person of  
10 ordinary creativity, according to KSR? So that wouldn't a person of  
11 ordinary creativity be capable of designing a hinge that would -- made of  
12 Velcro that would hold it upright?

13 MR. WERKING: A person of ordinary skill in the art is also a person  
14 of ordinary creativity, but we do not believe that a person of ordinary  
15 creativity in view of the Rago reference would have thought that that hinge,  
16 which is only disclosed as folding back and forth, could also make it stand  
17 upright.

18 JUDGE FREDMAN: But hinges are well known to be able to stand  
19 things up, right?

20 MR. WERKING: It's known that other hinges can stand things  
21 upright. In front of -- with the record in front of us, to my knowledge, it's  
22 not known that a Velcro hinge could accomplish that function.

23 JUDGE FREDMAN: Okay.

1 MR. WERKING: Further, the figures in Rago show that the board is  
2 quite large, much larger than the compacts to which this application is  
3 directed. The drawings --

4 JUDGE FREDMAN: Is there a size requirement for the compact?

5 MR. WERKING: In claim 1?

6 JUDGE FREDMAN: Yeah.

7 MR. WERKING: There's no size explicitly recited in the claim, but to  
8 meet the claim language in terms of the hooks and loops keeping it upright,  
9 the base portion of the lid would have to be small if you -- for example,  
10 you're using Velcro. But there's no explicit size requirement.

11 The drawing suggests that, if anything, the hinge is too weak to  
12 support the board in an upright position and, therefore, that if you held the  
13 board upright and then let it go, the board would just flop to the ground. At  
14 the least, Your Honors, there's no positive disclosure suggesting that any  
15 Velcro hinge in Rago could accomplish the function recited in claim 1. And  
16 in the absence of such a disclosure, it is unpredictable that the Velcro hinge  
17 in Rago could make the lid of a box stand upright.

18 Now I'll turn to the second argument. Rago is not analogous art.  
19 According to the Federal Circuit, a reference is analogous art if it is in the  
20 field of applicant's endeavor or, if not, if it is reasonably pertinent to the  
21 particular problem with which the applicant was concerned. Rago is clearly  
22 not in our field of endeavor. The Examiner appears to grant as much when,  
23 on page 12 of the Examiner's answer, the Examiner states that in this case  
24 Rago is reasonably pertinent to hinges.

1           This raises the question of how to analyze the second prong of the  
2 Federal Circuit's analogous art test, what makes a reference reasonably  
3 pertinent? The Federal Circuit provided such guidance in the case In Re  
4 Clay: The purpose of both the invention and the prior art are important in  
5 determining whether the reference is reasonably pertinent to the problem the  
6 invention attempts to solve. If it is directed to a different purpose, the  
7 inventor would accordingly have had less motivation or occasion to consider  
8 it.

9           JUDGE FREDMAN: If you look -- have you read In Re Icon Health?  
10 Are you familiar with that case? It's a case about gym equipment. And in  
11 that case -- I'll just read you a little piece of it -- the Court found that an  
12 inventor considering a hinge and latch mechanism for portable computers  
13 would naturally look to references employing other houses, hinges, latches,  
14 springs, et cetera, which in that case came from areas such as a desktop  
15 telephone directory, piano lid, a kitchen cabinet, a washing machine cabinet,  
16 a wooden furniture cabinet or two-part housing for storing audio cassettes.  
17 That's 496 F.3d 1374.

18           So it seems that Icon, which is a 2007 Federal Circuit decision, took  
19 hinges and indicated that a lot of different things can qualify as sort of  
20 analogous art for hinges. And the cite is In Re Paulsen, which actually is the  
21 case that was doing that analysis. The --

22           MR. WERKING: I'm sorry, I missed the last part.

23           JUDGE FREDMAN: It was citing In Re Paulsen, which is an older  
24 case from '94, which was actually doing the analysis. But Icon also dealt  
25 with hinges in some way.

1 MR. WERKING: Okay. I had not prepared to address that particular  
2 case. To the extent that that would apply, I stand by the remarks concerning  
3 In Re Clay and these other cases. Just standing here, I wouldn't be able to --

4 JUDGE FREDMAN: Sure.

5 MR. WERKING: So I'll continue. So Rago and this application are  
6 largely directed to entire -- to solving entirely different problems. And  
7 because Rago and this application are largely directed to solving entirely  
8 different problems, Rago would not be considered to be reasonably pertinent  
9 -- excuse me -- to solving the particular problem that this application is  
10 directed to solve.

11 Having summarized the two primary arguments, that Rago is not  
12 analogous art and that any combination of Rago and the other references  
13 would not have been predictable, I want to turn to the Examiner's reliance on  
14 case law in supporting the obviousness rejections of claim 1. First, the  
15 Examiner relies In Re Oetiker for the statement that analogous art must  
16 either be an applicant's skills of endeavor or reasonably pertinent to the  
17 problem with which applicant was concerned. That test is still good law, but  
18 it is important to note that Oetiker also strongly supports our position in this  
19 case as asserted on page two of the reply brief.

20 In particular, Oetiker is a case, like this case, involving hooks and  
21 nonanalogous art. In Oetiker the Federal Circuit overturned the Board by  
22 asserting that just because both the references disclosed hooks does not  
23 mean that one of skill in the art of hose clamps would look to the garment  
24 industry. Similarly, just because Rago discloses a Velcro hinge does not  
25 mean that one of skill in the art of cosmetics would have turned to the game



1 board industry to also seek a hinge other than a metal pin that would make a  
2 lid stand upright.

3         So in view of Your Honor's concerns about that case that you  
4 mentioned, it seems that there is a question just in terms of how far you can  
5 go from one art to another art, how likely you would know that another  
6 reference in a different art would happen to have a hinge in there that would  
7 solve the particular problem that you're looking for. And that seems to be a  
8 factual determination or a legal conclusion of obviousness the Examiner's  
9 made in this case, and I understand that there are certain cases on both sides  
10 mentioning hooks and hinges and so on, so I leave that to your discretion in  
11 reviewing the rejections.

12         The Examiner also relies on KSR. The reliance on KSR is misplaced  
13 for two fundamental reasons. First, KSR did not involve nonanalogous art.  
14 KSR involves analogous art. The sensor in that case was known to be  
15 placed in automotive pedals. Thus, nothing in KSR overturned the doctrine  
16 that, for the Examiner to rely on a reference in rejecting a claim as obvious,  
17 the reference must constitute analogous art.

18         Second, KSR reaffirms the Supreme Court's principle that  
19 obviousness is more likely to be justified when old features are combined to  
20 only produce their established functions and that obviousness is less justified  
21 when old features are combined to produce new or unpredictable outcomes.  
22 Specifically, the Court stated that when a patent simply arranges old  
23 elements each performing the same function it had been known to perform  
24 and yields no more that one would expect from such an arrangement, the  
25 combination is obvious.

1           That returns us to the point of the first argument, a new result, an  
2 unpredictable result. Claim 1 recites that the hinge is configured to hold the  
3 lid in an upstanding position relative to the at least one base portion. In the  
4 words of KSR, it is unpredictable that the Velcro hinge would accomplish  
5 that.

6           I will say one last thing about KSR. KSR was intended to reinstate a  
7 realistic approach to obviousness. That is, KSR was intended to free  
8 examiners and the courts from the restraints of the TSM test if that test  
9 would prevent them from declaring obvious a combination of features that  
10 realistically were obvious. This realistic approach to obviousness is  
11 reflected in the requirement in evaluating obviousness that examiners step  
12 backward in time and into the shoes worn by the hypothetical person of  
13 ordinary skill in the art when the invention was unknown and just before it  
14 was made. If we take the realistic approach and step backward in time and  
15 into the shoes of a person of skill in cosmetics art at the time of the  
16 invention, we find that such a person would not have found the Rago  
17 reference. The Rago reference is, as page 10 of the appeal brief notes, the  
18 sort of reference that is derived from a targeted key word search for our  
19 disclosure without context. It is unlikely that such a person of skill in the  
20 cosmetic arts back at the time of the invention would have found this  
21 reference in any other way than by searching for the key word Velcro --

22           JUDGE FREDMAN: Just one point. Claim 1 doesn't actually  
23 involve cosmetics, really, directly, does it?

24           MR. WERKING: I don't think --

25           JUDGE FREDMAN: Claim 1 is a box.

1 MR. WERKING: Claim 1 recites a box and then the --

2 JUDGE FREDMAN: So it could be --

3 MR. WERKING: -- the numerous --

4 JUDGE FREDMAN: -- in the art of game making. I mean, it  
5 encompasses -- a box could include a box to hold your Monopoly game.

6 MR. WERKING: Claim 1 is broadly worded. To the extent that I've  
7 said that one of skill in the art is the cosmetic arts, that is going to be more  
8 applicable to the many dependent claims that clarify that we're talking about  
9 the cosmetic arts.

10 JUDGE FREDMAN: You separately argue claim 38 and 39. Do you  
11 separately argue some of the other dependent claims?

12 MR. WERKING: The brief does not explicitly argue the dependent  
13 claims, but the brief argues the independent claims and then requests a  
14 withdrawal of the rejection of all of the claims.

15 JUDGE FREDMAN: Sure.

16 MR. WERKING: Rago is precisely the sort of reference that is so far  
17 removed from Applicant's field of endeavor and so largely directed to  
18 solving a different problem, that realistically at the time of the invention, one  
19 of skill in the cosmetic arts would not have encountered it.

20 Finally, I'll briefly discuss independent claims 38 and 39. First, the  
21 arguments about Rago being nonanalogous art, as explained previously,  
22 apply to claims 38 and 39 and for similar reasons. Second, as discussed at  
23 the top of page 11 of the brief on appeal, Seidler teaches a virtual hinge.  
24 The drawings in Seidler and paragraph nine explicitly state that the virtual  
25 hinge does not occupy any space between the hinge plates. The drawings in

1 paragraph 14 further show that the virtual hinge in Scidler is disposed inside  
2 of the plates, which the Office action asserts corresponds to the recited bases  
3 and lid.

4 Seidler strongly asserts that an advantage of its hinge is that the hinge  
5 does not occupy physical space between the plates. Seidler directs it --  
6 accordingly, Seidler directs its invention to a virtual hinge in which the  
7 magnets are located inside of the plates and not outside where they would  
8 take up more space and be less aesthetically pleasing. In view of Seidler's  
9 disclosure that an external hinge would be undesirable, it would not have  
10 been obvious at the time of the invention to replace any virtual hinge in  
11 Seidler with an external virtual Velcro hinge from Rago. Doing so would  
12 ruin the advantages that Seidler achieves in avoiding an external hinge.  
13 Accordingly, we request that all of the rejections be overturned.

14 And if there are no questions, that'll conclude my brief.

15 JUDGE ADAMS: All right. Thank you very much.

16 MR. WERKING: Thank you.

17 JUDGE ADAMS: That concludes the hearing.

18 (Whereupon, the hearing concluded on January 14, 2009.)  
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